IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of:

Kevin Donovan

Application No.: 09/385,802

Filed: August 30, 1999

For: Universal Instant Messaging
System For The Internet

Examiner: Dohm Chankong

Group Art Unit: 2152

Attorney Docket No.: 4031/1
15719US00

DECLARATION OF PROFESSOR LEE A. HOLLAAR

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Examiner Chankong:

1. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statement may jeopardize the validity of the application or any patent issued thereon.

2. I have personal knowledge of the subject matter of this declaration, and if called as a witness, would testify thereto.

3. My name is Lee A. Hollaar. I am a Professor of Computer Science in the School of Computing at the University of Utah, where I have been a faculty member since 1980. Prior to that, I was a faculty member at the University of Illinois at Urbana-Champaign. I received my Ph.D. in Computer Science from the University of Illinois at Urbana-Champaign in 1975.

4. As a professor at the Universities of Illinois and Utah, I have taught courses in software and system development. At the University of Utah, I initiated the course in data communications and computer networking in 1982 and have continued being one of the instructors for the course, and was the first Director of Campus Networking. I designed and supervised the implementation of the first campus-wide data networks at the University of Illinois at Urbana-Champaign and the University of Utah. As part of my research on specialized architectures for text information retrieval, I was responsible for probably the first client-server implementation of an information retrieval system, a technique now in common use such as with the USPTO's patent and trademark search systems.

5. I am also a Registered Patent Agent, the author of *Legal Protection of Digital Information* (BNA Books 2002), and teach computer and intellectual property law in the School of Computing. During my sabbatical in 1996-97, I was a visiting scholar at the Court of Appeals for the Federal Circuit. As part of the preparation for filing an amicus brief in the Supreme Court in their current patent case, *KSR v. Teleflex*, I have extensively researched the Federal Circuit's requirements for the combining of references to determine the obviousness of a claimed invention.

6. I have been retained to give my opinion as to whether the characterization of the references cited by the examiner is correct, whether the required

motivation to combine the cited references has been given, and whether the amended claims distinguish the invention over the Auerbach '937 patent.

MISCHARACTERIZATION OF THE REFERENCES

7. In my opinion, the examiner has mischaracterized the references in an attempt to make them conform to the claimed invention.

8. Nowhere is this more evident than in paragraph 8 on page 7 of the office action of April 12, 2006, where the examiner asserts that Figure 3 of the Aravamudan '609 patent shows "first and second users being associated with a first realm and a second realm" where the users are "conducting an instant messaging session ... over the Internet". Figure 3, as is clear from its description in the specification, shows nothing of the kind.

9. What Figure 3 really shows is how "A plurality of circuit voice traffic connections 182 are conveyed over the PSTN backbone 184 via regular PSTN circuit switches (not shown) and terminate their PSTN transmission at a Synchronous Transfer Mode (STM) switch 180." As defined in the specification, the PSTN is the conventional Public Switched Telephone Network, a circuit-switched network not at all like the packet-switched Internet.

10. Furthermore, the portions of the Aravamudan specification that the examiner cites have nothing to do with Figure 3. What the examiner has done is take the pending claims and occasionally interpose a reference to some figure or text in the Aravamudan patent that appears to show something like a part of the claim, without any regard to the overall teaching of the cited patent. This is a textbook example of viewing the prior art through the prism or lens of the claimed invention.

11. Similarly, the examiner mischaracterizes the Gudjonsson '261 patent as disclosing the general concept of "encrypting an instant message during the instant messaging session".

12. Gudjonsson clearly indicates the three places where encryption, through the use of the SSH protocol can be used in his system: "for all communications between clients and servers, between servers within a cluster, and between servers in different clusters." (Column 19, lines 37-39.) It does not teach the use of encryption between the two users and, in fact, ignores it as a possible technique. Because of that, Gudjonsson also teaches "Security may be enhanced by keeping the LAN in a locked room." (Column 14, lines 64-65.) If only encrypted messages between the users flow through the LANs and servers, there is no need for such enhanced security. And the attempted extension of Aravamudan to a multi-realm system yields the implausible situation of the operator of one realm depending for security on whether an independent operator of another realm locks his doors.

LACK OF A MOTIVATION TO COMBINE

13. As the Federal Circuit has noted, "the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to

combine prior art references. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) (citations omitted). "The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 989 (Fed. Cir. 2006).

14. In most instances, the examiner makes only the "mere conclusory statements" condemned by the Federal Circuit. For example, in paragraph 9 of the office action, the examiner states: "It would be obvious to one of ordinary skill in the art to incorporate encryption services into Aravamudan's communication system for the desirable function of having secured transmissions of network messages between users."

15. There is no indication of a reference, other than the application under examination, that teaches "the desirable function of having secured transmissions of network messages between users," particularly in the context of instant messaging or "chat rooms."

16. In paragraphs 8, 19, 21, and 37, the examiner makes another conclusory statement: that a prior art reference "does not expressly disclose encrypting instant messages but encryption of network data is rather ubiquitous and even expected in the art, as evidenced by Gudjonsson." Not only does Aravamudan not expressly disclose encrypting instant messaging, but it does not even imply such encryption. In fact, encryption is not even mentioned in Aravamudan.

17. Furthermore, if such a technique is "even expected in the art," then it is even more surprising that Aravamudan does not teach it. The omission of such an "expected" teaching in Aravamudan might even be considered a "teaching away" of encryption of instant messaging.

18. I have reviewed the references cited by the examiner, and it is my opinion that none of them provide the motivation to combine references to reach the invention of the claims (as amended) required by the Federal Circuit to support a finding of obviousness.

DISTINGUISHING OVER AUERBACH

19. I have reviewed amended claims 112 and 113, and it is my opinion that those claims are now clearly patentably distinct from the invention disclosed in the Auerbach '691 patent.

20. Auerbach discloses the use of plurality of "protocol services modules" with a "routing module" sending data from the API for the conversion platform to

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the appropriate protocol service module. There is a separate protocol service module required for each service provider. See column 6, line 65, through column 7, line 17, in Auerbach.

21.   In contrast, the present invention uses a single IM manager which retrieves information about the particular protocol needed for the first user to communicate with the second user from a database accessible to the first user. There is no need for either the separate protocol service modules or the router module which form the heart of the Auerbach invention as disclosed.

22.   Furthermore, there is nothing suggested in any other reference cited by the examiner to motivate changing Auerbach to the present invention.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon

Date: 10/11/2006

Lee A. Hollaar